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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 09/120,664
Filing Date: July 22, 1998
Appellant(s): David F. Gavin et al.

Dale Lynn Carlson RN 28,784
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed February 7, 2001.

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This is in response to appellant's brief on appeal filed February 7, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is essentially correct. However, it is noted that there was an election of species in paper no. 3 (dated 4/26/99) to which appellant elected zinc pyrithione as the elected species in paper no. 4 (dated 5/27/99). Accordingly, the search and rejections of record are directed to the elected zinc pyrithione embodiment.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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(5) *Summary of Invention*

The appellant's statement regarding the Summary of Invention is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 38, 40 and 41 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

A.	US Pat. No. 2,809,971	BERNSTEIN et al.	October 15, 1957
B.	US Pat. No. 5,776,960	OPPONG et al.	July 7, 1998
C.	US Pat. No. 5,821,271	ROENIGK	October 13, 1998
D.	US Pat. No. 5,916,947	MORRIS et al.	June 29, 1999
E.	JP 04-311206 (Abstract)	NAGATA et al.	August 16, 1994
F.	JP 05-297198 (Abstract)	FUJITA et al.	May 9, 1995

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(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. These rejections are reproduced in whole for the sake of convenience, but can be also be found in the final rejection (paper no. 9: dated March 3, 2000).

1. Claims 1, 38 and 40-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Bernstein et al., U.S. Pat. No. 2,809,971 (10/57).

Bernstein et al. disclose the formation of a biocidal composition comprising particles (e.g. precipitates) of Zn pyridinethione chelate complexes (e.g. see Examples 16, 19 and 22: col. 7 and 8) which can be added directly to the soil (e.g. sprinkled: see col. 10). The particle complex which possesses ingredients within the scope of the presently claimed would inherently possess the same physical parameters e.g. core and shell.

2. Claims 1, 38, 40 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Oppong et al., U.S. Pat. No. 5,776,960 (7/98: filed 10/96) and Bernstein et al. U.S. Pat. 2,809,971 which is incorporated by reference by the '960 patent (see '960 patent at col. 2, lines 6-15).

Oppong et al disclose synergistic biocidal compositions which comprise dry or tablet formulation (e.g. particles) of an ionene polymer and a metal salt, such as Zn pyridinethione chelate complexes as described in Bernstein et al. (See Examples 16, 19 and 22). The particle complex which possesses ingredients within the scope of the presently claimed would inherently possess the same physical parameters e.g. core and shell.

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3. Claims 1, 38 and 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Roenigk, U.S. Pat. No. 5,821,271 (10/98: filed 12/92)..

Roenigk disclose a biocidal dispersible (e.g. powder) composition (e.g. see col. 2, lines 40-46) comprising a chitosan zinc parathion complex (e.g. see col. 7, lines 6-32 and Table IV). The particle complex which possesses ingredients within the scope of the presently claimed would inherently possess the same physical parameters e.g. core and shell.

4. Claims 1, 38, 40 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by the Abstract to Nagata et al. JP 04-311206 (10/92).

Nagata et al. disclose a filter medium containing biocidal composition of particles comprising a zinc oxide core and shell of zinc parathion (and/or zinc undecylecin acid). The disclosed particulate biocidal composition clearly anticipates the presently claimed composite particles.

5. Claims 1, 38, 40 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by the Abstract to Fujita et al., JP 05-297198 (10/93).

Fujita et al. disclose a powder biocidal composition comprising a zinc pyridithione salt derivative (e.g. zinc 2-pyridine-thiol 1-oxide salt) alone or combined with zinc oxide. The particle complex which possesses ingredients within the scope of the presently claimed would inherently possess the same physical parameters.

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6. Claims 1, 38, 40 and 41 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Morris et al., U.S. Pat. No. 5,916,947 (6/99: filed 9/96 or earlier).

Morris et al. disclose a biocidal composition comprising zinc parathion powder (e.g. see col. 7, lines 4-10 and col. 8, lines 29-31 which meet the “composite particle” definition e.g. powder comprises particles; and zinc parathion is clearly the reaction product of zinc and parathion. The Morris et al. particle complex which possesses ingredients within the scope of the presently claimed would inherently possess the same physical parameters as presently claimed (e.g. core/shell structure.

Additionally, Morris et al. further discloses a biocidal particle composition (e.g. see col. 1, lines 10-20) that comprises a zinc core (e.g. zinc oxide) and a zinc parathion “shell” (e.g. see Example 1 and patent claims 1-17. The presence of ingredients as “composite particles” in the same presently claimed physical relationship (e.g. core/shell) would inherently result in the presently claimed “reaction product” of the parathion with a “portion” of the core metal (e.g. zinc/zinc oxide). Alternatively the reference explicitly teaches that zinc parathion acts as a “photosensitizer” which photosensitizes the core zinc metal. This photosensitizing effect would result in a “reaction product” within the scope of the presently claimed invention.

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(11) Response to Argument

1 Claims 1, 38 and 40-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Bernstein et al., U.S. Pat. No. 2,809,971 (10/57).

Bernstein et al. disclose the formation of a biocidal composition comprising particles (e.g. precipitates) of Zn pyridinethione chelate complexes (e.g. see Examples 16, 19 and 22:col. 7 and 8) which can be added directly to the soil (e.g. sprinkled: see col. 10). The particle complex which possesses ingredients within the scope of the presently claimed would inherently possess the same physical parameters e.g. core and shell.

Discussion

Appellant's arguments directed to the above anticipation rejection over the Bernstein et al. Reference were considered but deemed nonpersuasive for the following reasons.

Appellant argues that Bernstein et al fails to disclose "the instant composite particles". However, the Bernstein examples disclose a biocidal composition which contains the same components (e.g. a pyrrithione adduct and a zinc salt) as presently claimed. Further the reference teaches precipitates of these components which presumably comprise particles. Still further, the reference teaches the reaction product of zinc and a pyrrithione adduct which is also clearly within the scope of the present claim 1. Thus the composition and structure of claim 1 appears to be met by the various reference examples. Appellant's argument regarding the col. 10 disclosure is not responsive to the rejection which addresses the compounds of Examples 16, 19 and 22 and the disclosure of col. 7 and 8.

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Appellant's argument regarding the failure of the Bernstein reference to explicitly disclose the physical formation of "composite" particle (e.g. a shell/core structure) is not found persuasive.

As pointed out in the anticipation rejection and discussion above, the Bernstein reference discloses a composition in particle form which comprises the same components (e.g. zinc and pyrrithione) which possesses the same presently claimed utility (e.g. biocidal). Accordingly, as stated in the anticipation rejection above the prior art reference particle complex which possesses ingredients within the scope of the presently claimed would *inherently* possess the same physical parameters e.g. core and shell.

In this regard, where the claimed and prior art products are identical or substantially identical in structure or composition (as in the present case) or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the appellant and the prior art are the same, the appellant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). For a chemical composition and its properties are inseparable.

Therefore, since the prior art teaches the identical or substantially identical chemical structure, the properties appellant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658(Fed. Cir. 1990); and MPEP 2112.01.

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Appellant further argues that the Bernstein reference fails to teach the “enhanced biocidal efficacy” against both “soft-fouling” and “hard-fouling” organisms; pointing to specification pages 7 and 8.

This argument was considered but deemed nonpersuasive.

First, as pointed out above, the Bernstein reference biocidal composition is identical or substantially identical to the presently claimed biocidal composition; thus rendering any specific biocidal properties (e.g biocidal against soft/hard fouling organisms) necessarily inherent and anticipated. Thus, to the extent appellant’s argument can be construed as an assertion of unexpected results; such a showing although relevant regarding obviousness, is not germane to the above anticipation rejection.

Secondly, to the extent that appellant is arguing unexpectedly superior properties, appellant has failed to provide an adequate showing thereof by using a side-by-side comparison of the closest prior art product embodiment with a product within the scope of the presently claimed invention.

Accordingly, appellant’s arguments are not found persuasive.

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2 Claims 1, 38, 40 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Oppong et al., U.S. Pat. No. 5,776,960 (7/98: filed 10/96) and Bernstein et al. U.S. Pat. 2,809,971 which is incorporated by reference by the '960 patent (see '960 patent at col. 2, lines 6-15).

Oppong et al disclose synergistic biocidal compositions which comprise dry or tablet formulation (e.g. particles) of an ionene polymer and a metal salt, such as Zn pyridinethione chelate complexes as described in Bernstein et al. (See Examples 16,19 and 22). The particle complex which possesses ingredients within the scope of the presently claimed would inherently possess the same physical parameters e.g. core and shell.

Discussion

Appellant's argument directed to the above anticipation rejection over the Oppong et al. Reference in view of Bernstein was considered but deemed nonpersuasive.

Appellant argues that the combination of ionene polymers and pyrrithione salts are "physical mixtures" not composite particles wherein the shell comprises the reaction product of pyrrithione with a portion of the core. The Examiner respectfully disagrees.

As discussed above, the Bernstein examples disclose a biocidal composition which contains the same components (e.g. a pyrrithione adduct and a zinc salt) as presently claimed. Further the Bernstein reference teaches precipitates of these components which presumably encompasses particles. Further, the Bernstein reference teaches the reaction product of zinc and a pyrrithione adduct which is also clearly within the scope of the present claim 1. Thus the

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composition and structure of claim 1 appears to be met by the various reference examples.

Additionally incorporation of the ionone polymers is within the scope of the presently claimed invention which is open ended (e.g. composition comprising).

Further the pressing together of the ionene polymer and the Bernstein zinc parathion salts is well within the scope of "composite particles" as presently claimed (e.g. a tablet is composed of composite particles of zinc pyriithione salts and ionene polymer).

As pointed out in the anticipation rejection and discussion above, the Bernstein reference discloses a composition in particle form which comprises the same components (e.g. zinc and pyriithione) which possesses the same presently claimed utility (e.g. biocidal). The biocidal composition of the Oppong et al. reference composition merely represents a modification of the Bernstein reference composition to incorporate an ionene polymer

Accordingly, as stated in the anticipation rejection above, the prior art Oppong reference particle complex which possesses ingredients within the scope of the presently claimed would *inherently* possess the same physical parameters e.g. core and shell.

In this regard, where the claimed and prior art products are identical or substantially identical in structure or composition (as in the present case) or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the appellant and the prior art are the same, the appellant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709,

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15 USPQ2d 1655, 1658 (Fed. Cir. 1990). For a chemical composition and its properties are inseparable.

Therefore, since the prior art teaches the identical or substantially identical chemical structure, the properties appellant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658(Fed. Cir. 1990); and MPEP 2112.01.

Appellant further argues the nonobviousness of the presently claimed composition over the combined teaching of the Oppong and Bernstein references. In this respect, it is argued that there is no motivation to combine the Oppong and Bernstein references other than hindsight reconstruction.

This argument is not persuasive for the following reasons.

First, as pointed out the above rejection, the Bernstein reference biocidal composition, as modified by the Oppong et al. reference teaching, is identical or substantially identical to the presently claimed biocidal composition. Thus, appellant's argument addressing obviousness, is not germane regarding the above anticipation rejection.

Additionally, as discussed in the above rejection, the selection of the Bernstein pyrrithione and metal derivatives in the improved Oppong et al. composition is anticipated (e.g immediately envisaged) since the Oppong et al. reference specifically incorporates by reference the Bernstein pyrrithione and metal derivatives disclosed in the Bernstein patent (e.g. see Oppong et al. Col. 2, lines 7-15). See *In re Schaumann*, 572 F.2d 312. 197 USPQ 5 (CCPA 1978). Thus, the Oppong reference provides explicit and incontrovertible motivation to select from among the small number

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of metal pyrithiones disclosed in the Bernstein patent reference for utilization in the synergistic Oppong et al. reference composition.

Accordingly, appellant's arguments are not found persuasive

7. Claims 1, 38 and 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Roenigk, U.S. Pat. No. 5,821,271 (10/98: filed 12/92)..

Roenigk disclose a biocidal dispersible (e.g. powder) composition (e.g. see col. 2, lines 40-46) comprising a chitosan zinc parathion complex (e.g. see col. 7, lines 6-32 and Table IV).

The particle complex which possesses ingredients within the scope of the presently claimed would inherently possess the same physical parameters e.g. core and shell.

Discussion

Appellant's arguments directed to the above anticipation rejection over the Roenigk patent reference were considered but not deemed persuasive for the following reasons.

Appellant argues that the "chitosan-zinc-parathion complex" does not disclose or suggest "composite particles as instantly claimed". The Examiner respectfully disagrees.

The Roenigk patent reference composition is clearly biocidal. The reference discloses ingredients e.g. zinc and pyrithione, which clearly form a "reaction product" (e.g. zinc pyrithione) within the scope of the presently claimed invention. The presently claimed composition is open (e.g. comprising language) to additional ingredients which would include chitosan. The complex of zinc pyrithione chitosan is within the scope of "a composite" ; and the reference further teaches

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that the complex as either a precipitate or cake which clearly would comprise "particles" within the scope of the claimed invention. The particle complex which possesses ingredients within the scope of the presently claimed would inherently possess the same physical parameters e.g. core and shell.

In this regard, where the claimed and prior art products are identical or substantially identical in structure or composition (as in the present case) or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the appellant and the prior art are the same, the appellant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). For a chemical composition and its properties are inseparable.

Therefore, since the prior art teaches the identical or substantially identical chemical structure, the properties appellant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); and MPEP 2112.01

Accordingly, this rejection is hereby retained.

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8. Claims 1, 38, 40 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by the Abstract to Nagata et al. JP 04-311206 (10/92).

Nagata et al. disclose a filter medium containing biocidal composition of particles comprising a zinc oxide core and shell of zinc pyrithion (and/or zinc undecylecin acid). The disclosed particulate biocidal composition clearly anticipates the presently claimed composite particles.

Discussion

Appellant's arguments directed to the above Nagata et al. Reference were considered but deemed nonpersuasive for the following reasons.

Appellant argues that Nagata et al. discloses "physical mixtures" and not "composite particles" as presently claimed. The Examiner respectfully disagrees.

The Nagata et al. reference clearly teaches a "biocidal composition" (attached to a filter) which comprises a core and a surface layer each of which contains components (e.g. zinc in core as a zinc oxide; and surface layer of pyrithione) clearly within the scope of the presently claimed invention. The reference composition clearly "comprises composite particles" of zinc oxide; which is also within the presently claimed scope. Additionally, zinc pyrithione clearly encompasses the presently claimed "reaction product"

The Examiner is unclear as to the distinction appellant is making between "physical mixtures" and "composite particles"; but in any event upon mixing the above reference

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components a “composite” within the presently claimed scope would surely result since the reference composition contains ingredients within the scope of the presently claimed invention.

In this regard, where the claimed and prior art products are identical or substantially identical in structure or composition (as in the present case) or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). “When the PTO shows a sound basis for believing that the products of the appellant and the prior art are the same, the appellant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). For a chemical composition and its properties are inseparable.

Therefore, since the prior art teaches the identical or substantially identical chemical structure, the properties appellant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); and MPEP 2112.01

Assuming the relevancy of appellant’s distinction between a “physical mixture” and a “composite particle” ; it is noted that the Examiner lacks facilities to make a comparison between the prior art product and any specifically disclosed embodiment.

In any event the Examiner believes that the Nagata et al. reference clearly anticipates the presently claimed composition. The Examiner further believes that appellant’s purported distinction between “physical mixtures” and “composite particles” is merit less.

Accordingly appellant’s arguments are not found convincing.

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9. Claims 1, 38, 40 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by the Abstract to Fujita et al., JP 05-297198 (10/93).

Fujita et al. disclose a powder biocidal composition comprising a zinc pyridithione salt derivative (e.g. zinc 2-pyridine-thiol 1-oxide salt) alone or combined with zinc oxide. The particle complex which possesses ingredients within the scope of the presently claimed would inherently possess the same physical parameters.

Discussion

Appellant argues that Fujita et al. discloses “physical mixtures” and not “composite particles” as presently claimed. The Examiner respectfully disagrees.

Fujita clearly discloses a powder coating of components which are clearly within the presently claimed scope. The formation of a “powder coating” is clearly within the scope of the presently claimed “composite particles”.

As pointed out in the above anticipation rejection, the Fujita particle complex further possesses ingredients within the scope of the presently claimed; and thus the Fujita particle composition would inherently possess the same physical parameters.

In this regard, where the claimed and prior art products are identical or substantially identical in structure or composition (as in the present case) or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). “When the PTO

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shows a sound basis for believing that the products of the appellant and the prior art are the same, the appellant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). For a chemical composition and its properties are inseparable.

Therefore, since the prior art teaches the identical or substantially identical chemical structure, the properties appellant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); and MPEP 2112.01

Accordingly appellant’s arguments are not found convincing.

10. Claims 1, 38, 40 and 41 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Morris et al., U.S. Pat. No. 5,916,947 (6/99; filed 9/96 or earlier).

Morris et al. disclose a biocidal composition comprising zinc parathion powder (e.g. see col. 7, lines 4-10 and col. 8, lines 29-31 which meet the “composite particle” definition e.g. powder comprises particles; and zinc parathion is clearly the reaction product of zinc and parathion. The Morris et al. particle complex which possesses ingredients within the scope of the presently claimed would inherently possess the same physical parameters as presently claimed (e.g. core/shell structure.

Additionally, Morris et al. further discloses a biocidal particle composition (e.g. see col. 1, lines 10-20) that comprises a zinc core (e.g. zinc oxide) and a zinc parathion “shell” (e.g. see Example 1 and patent claims 1-17. The presence of ingredients as “composite particles” in the

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same presently claimed physical relationship (e.g. core/shell) would inherently result in the presently claimed “reaction product” of the parathion with a “portion” of the core metal (e.g. zinc/zinc oxide). Alternatively the reference explicitly teaches that zinc parathion acts as a “photosensitizer” which photosensitizes the core zinc metal. This photosensitizing effect would result in a “reaction product” within the scope of the presently claimed invention. .

Discussion

Appellant’s arguments directed to the above anticipation rejection were considered but deemed nonpersuasive for the following reasons.

Appellant argues that the ‘947 patent contains a “wish list” of photosynthesizers one of which is zinc parathion.

Although the ‘947 patent does contain a list of about 10 photosensitizer (e.g. see col. 4, lines 15-28); the ‘947 patent specifically exemplifies a “zinc pyrrithione powder” (e.g. see ‘947 col. 8, line 29) which is asserted in the first paragraph of the anticipation rejection above to be within the scope of the presently claimed composition. This part of the anticipation rejection recited above has not been specifically rebutted by the appellant.

Appellant further argues that the ‘947 patent discloses a photosensitizer being “surface coated” onto zinc oxide. As such it is further argued that “[S]ince the Morris photosensitizer is “surface coated” onto the zinc oxide, the surface coating CANNOT provide a shell wherein the shell comprises a **reaction product** of a pyrrithione with a portion of the core metal or meal compound (emphasis provided by appellant)..

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Appellant's argument in addressing the second paragraph of the above anticipation rejection fails to appreciate both the reference teaching taken as a whole; and how such a teaching is being applied in the second paragraph of the above anticipation rejection.

As pointed out in the above rejection, the '947 patent reference specifically discloses "particles" which comprise (at least 20%) zinc oxide and (less than about 5% photosensitizer) for their ultimate use as antifouling "coating compositions". See eg., '947 col. 1, lines 10-20; Patent claim 1. The '947 reference further teaches that these "particles" can be present in "powder or slurry form". See e.g. '947 col. 2, lines 42-55. As discussed above, although the '947 patent does contain a list of about 10 photosensitizers (e.g. see col. 4, lines 15-28; patent claim 1); the '947 patent specifically exemplifies a "zinc pyrrhione powder" (e.g. see '947 col. 8, line 29).

Accordingly, as pointed out in the second paragraph of the anticipation rejection above, the Morris et al. patent reference thus discloses a biocidal particle composition (e.g. see col. 1, lines 10-20) that comprises a zinc core (e.g. zinc oxide) and a zinc parathion "shell" (e.g. see Example 1 and patent claims 1-17 within the scope of the presently claimed invention..

For, the presence of ingredients as "composite particles" in the same presently claimed physical relationship (e.g. core/shell) *would inherently result* in the presently claimed "reaction product" of the pyrrhione with a "portion" of the core metal (e.g. zinc/zinc oxide).

Alternatively as pointed out in the above rejection, the reference explicitly teaches that zinc pyrrhione acts as a "photosensitizer" which photosensitizes the core zinc metal. This

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photosensitizing effect would result in a "reaction product" within the scope of the presently claimed invention.

In this regard, where the claimed and prior art products are identical or substantially identical in structure or composition (as in the present case) or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the appellant and the prior art are the same, the appellant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). For a chemical composition and its properties are inseparable.

Therefore, since the prior art teaches the identical or substantially identical chemical structure, the properties appellant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658(Fed. Cir. 1990); and MPEP 2112.01

The Examiner lacks the experimental facilities to make a comparisons between the prior art and the presently claimed compositions.

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Accordingly, it is respectfully requested that the above anticipation rejections of record, for the reasons recited above and already of record, should be affirmed.

General information regarding further correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

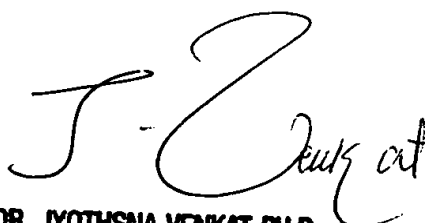
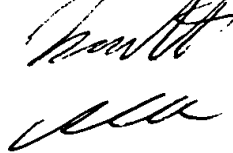
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat (art unit 1627), can be reached at (703)308-0570.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

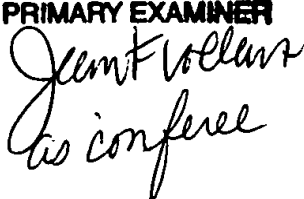
Respectfully submitted,

Bennett Celsa (art unit 1627)
April 17, 2001

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